

REMARKS

This amendment is submitted in response to the Final Official Action mailed January 20, 2006, to request reconsideration of the application in view of the remarks set forth herein.

Applicant submits that the amendment is fully responsive to the outstanding Official Action for at least the reasons set forth below.

At the onset, Applicant notes that Claims 21-32 have been cancelled herewith and new Claims 33-40 have been submitted herewith for examination. Claims 33-40 are submitted to clarify the invention. Claim 33 is directed to a surgery system comprising, *inter alia*, a first and second medical device, the first medical device includes a first connecting portion capable of detachably connecting a treatment equipment, the first medical device driving the treatment equipment connected to the first connecting portion, a first judging portion for judging the type of the treatment equipment connected to the first connecting portion in response to replacement of the treatment equipment connected to the first connecting portion, and a first medical device control portion for outputting judging information corresponding to the type of the treatment equipment judged by the first judging portion when the treatment equipment connected to the first medical device is replaced, and outputting a first drive signal to drive the treatment equipment connected to the first medical device in response to the activation of a first switch. The first switch is connected to the first medical device. The second medical device includes a control for generating a second drive signal to drive the second medical device in response to the activation of a second switch, making permission/non-permission determination regarding whether or not the first medical device is to be synchronized with the second medical device in response to the judging information outputted from the first medical device control portion, and outputting the second drive signal to drive the second medical device in response to the

activation of the first switch if it is judged that the first medical device is to be synchronized with the second medical device. No new matter has been added by the submission of Claims 33-40.

In the claimed invention, the medical devices themselves independently control the medical device without the use or need of a central host computer. Each device sends and receives information relative to the connecting and driving status of the other device. Based upon the received information, synchronization is determined and the driving control is changed. Accordingly, there is no need for a separate and additional controller dedicated to manage information and the functionality of the devices. Thus, the claimed invention has the advantage that when a new medical device or equipment is added to the surgery system which was not previously connected, only the corresponding device and the other device is needed to determine and execute the necessary control processes, such as permission and synchronization, without needing to reset or change the settings of a host computer or change a program within the host computer.

Applicant submits that any combination of Applebaum and Whitman (both previously cited) do not teach the claimed system and control structure. Applebaum and Whitman both teach that a host computer or program typically controls the control functions of the attached medical devices and equipment. Whitman teaches that when a new device is attached, the new parameters are stored in the control system (remote from the device) and the control system adjusts the control parameters, operating program and algorithm based upon the new parameters. Applebaum teaches that a central computer constitutes a user interface by which the user (such as a surgeon, medical technician or assistant) receives information representative of the various operating parameters of microsurgical instruments 19 and peripherals which provide the different functions needed to perform the surgical procedures. The user also provides information to the

system via a graphical user interface provided by computer. The computer stores programmable operating parameters for each of the microsurgical instruments. By providing information to central processor 245 via the user interface, the user is able to reprogram or select from the operating parameters. The computer unit then communicates the operating parameters to modules. In this manner, the user is able to optimize the performance of instruments 19 during surgery. The user either programs the operating parameters, selects them from a set of default operating parameters or inputs them directly from the user interface to optimize performance of the surgery in the central computer. Accordingly, if a new device is connected in either Appelbaum or Whitman, any information regarding the type of device, any control parameters and synchronization would be transmitted to the central computer and any change the settings for the devices would be made by using the central computer to change the programming and algorithms accompanying all of the devices, to reflect the change in the replaced device. Both references suggest that the judged type of treatment equipment is sent to the central controller, computer, remote controller and not to another connected medical device. In contrast, in the claimed invention the judged type of treatment equipment is output to the other medical device.

Additionally, Applebaum only teaches that if both devices are already attached, a first device can prevent the second device from functioning. However, Applicant notes that Applebaum does not teach how this function is performed. The claimed invention judges synchronization when a device is **first attached** and driven and not just driven. In contrast, Applebaum's judgment is only based upon "when a device is driven".

Moreover, Applebaum states that "it may be desirable to prevent certain instruments 19 from operating simultaneously for safety reasons. For example, the phacoemulsification instrument is disabled by the bipolar coagulation instrument when the latter is being used and

vice-versa. In contrast, the aspiration function is needed during phacoemulsification or phacofragmentation. Thus, information regarding both functions is communicated via the network between the phaco module 325 and either venturi IAV module 321 or scroll IAV module 323". See Col. 18. In other words, the first device disables the second device when the first device is switched on. However, Claim 33 recites that the **second medical device control portion** makes permission/non-permission determination regarding whether or not the first medical device is to be synchronized with the second medical device in response to the **judging information outputted from the first medical device control portion**, and outputting the second drive signal to drive the second medical device in response to the activation of the first switch, **if it is judged that the first medical device is to be synchronized with the second medical device**. In other words, the second device prevents the second device from being driven, if non-permission is determined, not the first device preventing the second device and vice versa.

Accordingly, Applicant submits that independent Claim 33 is patentably distinct from any of the references cited in the Final Official Action.

In addition to being patentable based upon the reasons set forth above, Claim 34 is further patentable based upon the following reasons.

None of the cited references teach that the synchronization is based upon both (i) a judgment signal regarding a newly added device and (ii) a signal regarding the switching regarding the newly added device. Both signals must be transmitted to the other device before synchronization is determined.

Accordingly, Applicant submits that independent Claim 34 is patentably distinct from any of the references cited in the Final Official Action.

In addition to being patentable based upon the reasons set forth above, Claims 36 and 37 are further patentable based upon the following reasons. Claim 36 recites, *inter alia*, wherein the first medical device control portion outputs the drive information of the first medical device to the second medical device control portion **with a predetermined interval**, and the second medical device control portion determines that the second medical device **is not to be synchronized with the first medical device if the drive information from the first medical device control portion is not received within a preset period of time**. Claim 37 recites, *inter alia*, wherein the first medical device control portion outputs the drive information of the first medical device to the second medical device control portion **with a predetermined interval**, and the second medical device control portion **stops the driving of the second medical device if the drive information from the first medical device control portion is not received within a preset period of time**.

None of the cited references teach the claimed predetermined interval and control function. In the outstanding Final Official Action, the Examiner asserted that Fischer discloses the claimed timeout feature and control function. Applicant respectfully disagrees. While Fischer appears to teach a watchdog timer, the reference does not teach (A) determining that the second medical device is not to be synchronized with the first medical device if the drive information from the first medical device control portion is not received within a preset period of time, and (B) stopping the driving of the second medical device if the drive information from the first medical device control portion is not received within a preset period of time.

The "program sequence" disclosed in Fischer is not the same as the claimed function. This rejection is nothing more than hindsight and based upon an obvious to try reasoning. However, obvious to try is not the standard for a § 103 rejection. Fischer does not give any

direction or guidance to modify the reference to arrive at the claimed function. Additionally, there is no motivation to combine Fischer with the other references. Applebaum only suggests sending information when needed.

Therefore, Applicant submits that the Examiner has not established a *prima facie* case for obviousness. The Examiner has not provided a proper motivation to combine the references, which is dispositive of an obviousness case. To establish obviousness, the Examiner must make a showing of a suggestion or motivation in the art to combine the references. In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002) (Citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The motivation can come from the nature of the problem, the reference, or common knowledge. Id. The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the

invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct the suggestion to combine [modify] requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 U.S.P.Q.2d 1457-58 (Fed. Cir.1998) (citations omitted, emphasis added).

Obviousness cannot be based upon what a person of ordinary skill in the art could or might try, but rather upon what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 U.S.P.Q. 6 (CCPA, 1977).

Since there is no teaching of sending information at constant intervals, there is no motivation to combine Fischer with the other references. While Fischer teaches a watchdog timer, there is no suggestion or teaching in Fischer or any reference to include the watchdog timer in a surgery system analogous to the claimed invention.

Therefore, Claims 36 and 37 are patentably distinct from the hypothetically combined references.

Furthermore, Applicant submits that Claims 35 and 38-40 are patentably distinct from any and all of the cited references, whether taken alone or in any combination thereof, based at least upon the reasons set forth above with respect to independent Claim 33.

Based upon the foregoing, Applicant submits that new Claims 33-40 are patentable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice

of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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